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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,238	12/28/2001	Shinichi Hirata	217537US-6 DIV	6314
22850 7590 04/11/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BROWN, RUEBEN M	
			ART UNIT 2623	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/11/2007	ELECTRONIC

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<b>Office Action Summary</b>	<b>Application No.</b> 10/029,238	<b>Applicant(s)</b> HIRATA	
	<b>Examiner</b> Reuben M. Brown	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/039,922.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 17, 23 & 30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 6 of U.S. Patent No. 6,374,406, hereinafter referred to as ‘406. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed limitations of the present application, merely represents a broader version of the patented limitation.

In particular, claims 17 & 23 of the present application corresponds with claim 1 of the ‘406. Claims 17 & 23 of the instant application, recites, ‘A reception device for controlling a

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recording module, comprising: means for receiving (a receiver configured to receive) a formatted file transmitted through a network'. Whereas, '406 recites, 'A reception device for controlling an electric appliance, comprising: a reception means for receiving an electronic mail transmitted through a network'. It is asserted that 'a formatted file' is a broader version of 'an electronic mail', as recited in '406.

Claims 17 & 23 of the present application also recites, 'means for extracting (a processor configured to extract) at least one text-based control command in said formatted file received by said means for receiving (by said receiver), wherein said text-based control command is in said formatted file to control said recording module'. Whereas '406 recites, 'extraction means for extracting a control command added to said electronic mail received by said reception means, wherein said control command is added to said electronic mail to control said electronic appliance. The claimed features of the present application are broader version of the '406 patent, as discussed in the above paragraph.

Furthermore claims 17 & 23 of the present application recites, 'means for controlling said recording module based on said text based control command extracted by said means for extracting, wherein said means for controlling has a timer reservation function, and said means for controlling reserves an operation time of said recording module'. Whereas '406 recites, control means for controlling said electronic appliance based on said control command extracted by said extraction means, wherein said electric appliance is physically remote from said control means, wherein said control means has a timer function, and said control means reserves an

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operation of time of said electric appliance'. The claimed features of the present application are broader version of the '406 patent, as discussed in the above paragraph.

Similar to the above analysis claim 30 of the present application, corresponds with claim 6 of '406. In particular, claim 30 of the present application, recites 'A reception method for controlling a recording module, comprising the steps of: 'receiving a formatted file transmitted through the network, whereas, claim 6 of '406 recites, 'A reception method for controlling an electric appliance, comprising the steps of receiving an electronic mail transmitted through a network'. The claimed 'formatted file' is a broader version of the claimed 'electronic mail'.

Claim 30 of the present application recites, 'extracting at least one text-based control command in said formatted file received in said receiving step, wherein said text-based control command is in said formatted file to control said recording module', whereas, claim 6 of '406, recites 'extracting a control command added to said electronic mail, wherein said control command is added to said electronic mail to control said electronic appliance'. Finally, claim 30 of the present application recites, 'controlling said recording module based on said text-based control command extracted by said extracting step, wherein said step of controlling has a timer reservation function, and said step of controlling reserves an operation time of said controlling module', whereas claim 6 of '406 recites 'said step of controlling has a timer reservation function and said of controlling reserves an operation time of said electric appliance'.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blake, (US PG-PUB 2003/0031465), in view of Abraham, (U.S. Pat # 4,567,512).

Considering claims 17 & 23, the claimed reception device for controlling a recording module, comprising:

‘means for receiving a formatted file through the network’ reads on the personal computer, PCTV or set top box, Para [0027]-[0027] & [0031] & [0089].

‘means for extracting at least one text-based control command in said formatted file received by the means for receiving, wherein the text-based control command is in the formatted file to control the recording module’, reads on the disclosure in Blake that the user may send recording requests via an e-mail account via the processing system 334. The processing system 334 transmits the requests to the user’s recoding device 336.

'means for controlling the recording module based on the text based control command extracted by the means for extracting, such that the means for controlling has a timer reservation function and the means for controlling reserves an operation time of the recording module' is met by the disclosure of Blake, which teaches that control codes may be transmitted through a telecommunications network to activate and control a VCR at a subscriber's residence to record a program specifically requested by the user. Blake also teaches that the user may send an e-mail message to processing system 334, [0089]-[0093].

However, Blake does not explicitly teach the reference uses the timer reservation function of the recording module. Nevertheless Abraham, which is in the same field of endeavor provides a teaching of a user requesting to record a program that will be broadcast in the future, (Abstract). The library receives the request and transmits timer reservation information via telephone line, which is stored by a microprocessor 98 at the user equipment. At the appropriate time, the stored information is released and used by the VCR to record the program, (col. 7, lines 50-67; col. 8, lines 5-15). It would have been obvious of ordinary skill in the art at the time invention was made, to modify Blake with the teaching of using a recording module timer reservation function as taught by Abraham, (col. 3, lines 21-32) at least for the advantage of having the timer reservation information already stored at the receiver at broadcast time, which overcomes the problem of not recording the requested program if there is a transmission error if the control command is transmitted at the time of broadcast of the request program.

Thus, the combination of Blake & Abraham would teach one of ordinary skill in the art, to provide the text-based control commands, for instance by e-mail, as discussed in Blake to a recording module, prior to transmission of the broadcast and set the reservation timer function of the recording module to automatically record the program, at the time of its broadcast.

Considering claims 18, 24, 31, 36, 41 & 48, Blake teaches that a PC, PCTV, laptop, STB or any other device capable of transmitting data from a remote location, including by use of a modem, [0089] and that the devices may operate using a web browser, which reads interprets data transmitted over the Internet, [0027], [0041] & [0093].

Considering claims 19, 25, 32, 37, 42, & 49, Blake discloses that the processing system 334 stores the recording information, [0089], whereas Abraham more explicitly teaches storing the recording information at the subscriber equipment.

Considering claims 20-21, 26-27, 33-34, 38-39, 43-44 & 50-51 the claimed TV recording module, reads on the VCR unit at the subscriber site, [0089] and the subscriber equipment of Abraham, Figs. 1-4.

Considering claims 22, 29 & 46, the claimed subject matter reads on Para, [0034] & [0079].



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Considering claims 28 & 45, Blake discusses that the receiver may include a modem, [0026], [0030].

Considering claims 30, 35, 40, 45 & 47, the claimed transmission/reception device comprising elements that corresponds with subject matter mentioned above in the rejection of claims 17 & 23 is likewise treated. As for the claimed 'transmitter' or 'means for transmitting', reads on the remote location used by a subscriber to schedule recordings on their home VCR, [0089].

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A) Yamada Remote system for operating a VCR, via e-mail.
- B) Boyer Teaches transmitting a reminder to tune to a program via e-mail, [0087].
- C) Hanafee Transmitting notification or reminder for recording a TV program.

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**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O. Box 1450  
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**or faxed to:**

(571) 273-8300, (for formal communications intended for entry)

**Or:**


(571) 273-7290 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown

  
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PRIMARY PATENT EXAMINER  
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